

REMARKS

Claims 11, 15, 16 and 19 have been rejected as allegedly being anticipated by U.S. Reissue Patent No. RE. 32,476 to Kistner (hereinafter “Kistner”) and claims 12-14, 17, 18, and 20-27 have been rejected under as allegedly being unpatentable over Kistner. Applicant respectfully traverses these rejections.

Claim 11 of the present application defines “a plant cultivating substrate produced by reacting: a water-retentive filling material, water, urethane prepolymer and a polyol under conditions which form a plant cultivating substrate.”

According to the plant cultivating substrate of claim 11, the addition of a polyol imparts the water absorptivity, shape retentivity and flexibility (restorability) and the like suitable for plant cultivation.

On the other hand, Kistner describes reacting a water-retentive filling material, water, and a urethane prepolymer, but fails to neither disclose nor suggest further adding a polyol in the reaction of these substances. More specifically, in Kistner, the polyol is used only for reacting with isocyanate for the purpose of preparing a urethane prepolymer (column 2, lines 37 to 42), and is not added to the reaction as a separate component from the urethane prepolymer. Therefore, in Kistner, polyol does not exist in the reaction system when the substrate is produced.

In this regard, the Examiner stated that even though the production processes are different between the plant cultivating substrate of claim 11 of the present application and the substrate of Kistner, claim 11 is unpatentable if the products are the same.

However, the plant cultivating substrate of claim 11 of the present application is different from the substrate of Kistner, as product. Specifically, as in claim 11 of the

present application, when a polyol is present in the reaction system at a step of fabricating the substrate, a part of the polyol may react with the urethane prepolymer, but a large amount of non-reacted polyol is also present since their contact with the urethane prepolymer is blocked by the water-retentive filling material, water and the like. As the substrate is formed, the polyol with unreacted hydroxyl groups are taken into the substrate, and thus numerous hydroxyl groups can be introduced to the substrate. As a result, performance such as hydrophilicity of the substrate can be improved with the claimed invention.

On the other hand, in Kistner, hydroxyl groups of the polyol are used up in the reaction with isocyanate, and no polyol is present in the reaction system at the step of fabricating the substrate. Accordingly, it is impossible to introduce hydroxyl groups to the substrate and it cannot be expected to obtain the above-mentioned effect. That is, the Kistner process teaches away from the claimed invention.

Therefore, the product obtained by the reaction of a water-retentive filling material, water and a urethane prepolymer, as well as a polyol, as described in claim 11 of the present application, is not disclosed in Kistner, nor obvious from Kistner, and thus we believe that claim 11 is patentable.

The Examiner cannot simply contradict and/or modify the clear teaching of the reference to render the claims unpatentable. Moreover, applicant respectfully notes that the Examiner's position in conflict with the recent Federal Circuit decision: "Because the hallmark of anticipation is prior invention, the prior art reference — in order to anticipate under 35 U.S.C. § 102 — must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008)

Claim 21 of the present invention defines “a method of fabricating a plant cultivating substrate comprising reacting and curing (i) a water-retentive filling material, (ii) water, (iii) a urethane prepolymer and (iv) a polyol wherein said water-retentive filling material under dry conditions is from 15 to 60 wt.% of said plain cultivating substrate.”


Like in the claimed invention according to claim 11 of the present application, the reaction is performed in the presence of a water-retentive filling material, water, and a urethane prepolymer, as well as polyol, and thus we believe that claim 21 is also patentable for the same reasons set forth herein with respect to claim 11.

Accordingly, Kistner does not anticipate nor render obvious pending claims 11-27 of the claimed invention for the reasons set forth herein, and respectfully requests that these rejections based on Kistner be withdrawn.

Please charge the 3-month extension fee and the Request for Continued Examination fee to the credit card. Attached is the PTO FORM PTO 2038. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to our Deposit Account No. 50-0624, under Order No. NY-KIT 404-US (10513311) from which the undersigned is authorized to draw.

Dated: December 7, 2009

Respectfully submitted,

By 

C. Andrew Im
Registration No.: 40,657
FULBRIGHT & JAWORSKI L.L.P.
666 Fifth Avenue
New York, New York 10103
(212) 318-3000
(212) 318-3400 (Fax)
Attorney for Applicant